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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/999,730 12/24/97 STAAT

R 7311-24RE

EXAMINER

PM82/0313

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2005 MARKET STREET 22ND FLOOR
PHILADELPHIA PA 19103-7086

MORANO IV, S

ART UNIT

PAPER NUMBER

3617

DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/999,730

Applicant(s)

STAAT, ROBERT H.

Examiner

S. Joseph Morano

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. Correction of the following formalities in the claims is suggested to improve their readability:

- 1) On line 14 of claim 6, --which-- should be inserted before "curves".
- 2) On line 2 of claim 11, "extends" should read --extending--.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, on line 3 of the claim, "at least one stop" is confusing, as it is unclear how this is related to the previously recited "stops" above. It is noted that this problem occurred with the reintroduction of the stop limitations in the independent claim. It is suggested that going back to the original wording of claim 5, or the insertion of the word --said-- after "one" would correct this problem. Should applicant return to the original wording of the claim, applicant is reminded that underlining and bracketing should be shown relative to the original text of the patent claims.

Reissue Applications

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

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The supplemental declaration states that the above-identified error occurred without deceptive intent. This is confusing; however, since there are multiple identified errors. It is suggested that a new supplemental declaration containing a catchall statement should correct this problem (see example in paragraph below).

5. Claims 2-20 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

6. Claims 9-21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the

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meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, the claims improperly remove limitations that the prosecution history of the parent application indicates were essential to the allowance of the application. The reasons for allowance in the original applicant specifically state that the allowance of the application was because of "the combination ***of all of the features claimed in claim 7***, in particular with the use of two stops on the coupling head for limiting pivotal movement of the coupler knuckle against the spring" (emphasis added). Because the application was allowed based on these limitations, and because applicant did not disagree with the reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered broader coverage outside of the scope of claim 7. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims beyond what the prosecution history indicated as being essential to patentability. It is suggested that the deleted material of claim 7 be reinstated in the independent claims to place the application in condition for allowance and eliminate the recapture.

In claim 9, the limitation of the *drawbar capable of being pivotally mounted within a coupler pocket in the end of a model railroad car* is missing.

In claims 10-15, the limitation of the drawbar *capable of being pivotally mounted within a coupler pocket in the end of a model railroad car* is missing.

In claims 10, 12-15, the limitations of a *leaf spring being formed as an integral part of the first end of the drawbar and extending from the first end of the drawbar* is missing.

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In claim 11, the limitation of the leaf spring *being formed as a integral part of the first end of the drawbar* is missing.

In claims 16-21, the limitation of the *drawbar capable of being pivotally mounted within a coupler pocket in the end of a model railroad car* is missing.

In claims 16, 18-21, the limitations of a *leaf spring being formed as a integral part of the first end of the drawbar and extending from the first end of the drawar* is missing.

In claim 17, the limitation of the leaf spring *being formed as a integral part of the first end of the drawbar* is missing.

Allowable Subject Matter

7. Claims 2-20 are allowable over the prior art of record.

Response to Arguments

8. Applicant's arguments filed 12/28/2000 have been fully considered but they are not persuasive.

Specifically, applicant argues that the recapture rejection was improper, because of a "lacking in evidence of a clear agreement by the inventor or his attorney with the examiner's statement of reasons for allowance". Applicant additionally argues that although the limitations of the "stops" have been reintroduced into the claims, applicant is within his right to file broadened claims because the reissue was filed within two years, and is therefore entitled to delete the "leaf spring" limitations. Applicant finally "traverses" the statutory grounds for the rejection based on a defective reissue declaration.

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In response to applicant's first argument, it is believed that the evidence of record clearly does show applicant's acceptance of the examiner's reason for allowance, and thus applicant's statement in this regard is factually inaccurate. As set forth in paragraph 2 of the Office action mailed 10/31/95 in parent application 08/292,880: "Any comments ***considered necessary by applicant*** must be submitted no later than the payment of the Issue Fee..." (emphasis added). Because no comments as to why the application was being allowed were considered necessary by applicant, applicant agreed on the record with the examiner's statement. Thus, the evidence of record does in fact show that applicant acquiesced to these reasons for allowance, which indicated it was the combination of "all of the features claimed in claim 7". While applicant may wish to reconsider this acquiescence during the reissue process, such reconsideration is specifically prohibited by the recapture doctrine.

In response to applicant's second argument, the examiner agrees that applicant is entitled to ***file*** broadened claims. However, if such claims attempt to recapture material surrendered during prosecution of the original patent, applicant is not entitled to allowance of such claims.

Finally, while the examiner appreciates the logistical difficulty in obtaining signatures on declarations, the offer to supply a declaration does not overcome the rejection for the faulty one of record. The statutory basis for the rejection is clearly set forth above. Applicant's current supplemental declaration of record is not clear as whether all of the corrected errors occurred without deceptive intention, as required.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Supervisory Patent Examiner Morano can generally be reached Monday through Thursday, 7:30am-5:00pm.

Sjm
March 9, 2001



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